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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,185	12/15/2003	Nobuo Sugino	F-8064	4336
28107	7590	02/09/2006	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/736,185	Applicant(s) SUGINO, NOBUO	
	Examiner Sue A. Purvis	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,10,11 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,10,11 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 December 2005 has been entered.
2. Applicant's representative, Ricardo Unikel, requested the examiner call before working on the case. A call was placed February 3, 2006, but the examiner was unable to get in touch with the representative. If an interview is desired by the applicant now that the examiner has worked on the case, one can be arranged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 23, 24, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. There is not support found in the specification for using a pair of scissors to cut the transfer sheet as required by claims 23 and 26. Applicant has pointed to

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the drawings and various locations in the specification as showing support for all the new claims, but the examiner did not find support for cutting the transfer sheet either in drawings or in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In claim 1, lines 8-10, and claim 2, lines 2-5, after the phrase "including" applicant lists several types of adhesive, but it is unclear if these adhesives are part of the claimed invention. They seem to be examples of the adhesive which can be used invention, but the scope of the claim is unclear. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 5, 10, and 11 are rejected under 35 U.S.C. 102(b) as anticipated by Brault et al. (US Patent No. 5,601,959).

Brault discloses a transfer method comprising the steps of (Figures 1-12; column 4, line 38 to column 9, line 63):

(1) Providing a transfer sheet comprising a carrier (24) and transferable overcoating layer (26) (column 4, lines 20-35);

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(2) Providing a pattern (18) onto the upper surface of the transfer sheet by electrophotographic printing (column 4, lines 38-62);

(3) Applying an adhesive (22) onto the image (18) disposed on the surface of the transfer sheet (24, 26) (column 5, line 41 to column 6, line 17);

(4) Contacting under the effects of pressure and/or heat, the adhesive coated transfer sheet (24, 26, 18, 22) with a target substrate (20) to bond and transfer the image (18) onto the substrate (20) via the adhesive layer (22) (column 6, lines 27-63); and

(5) Stripping or peeling the carrier (24) of the transfer sheet (24, 26) from the image (18) adhesively bonded to the substrate (20) (column 6, lines 64-68).

Regarding applicant claim 1, Brault discloses the adhesive may comprise a pressure-sensitive, such as 3M Scotch Brand Spray Mount (a transparent adhesive), heat activated adhesives such as those based on thermoplastic polyurethane, polycaprolactone, and acrylic copolymers (column 5, lines 41 to column 6, line 26). While there is no specific mentioning of the surface tension of the adhesive, it is appreciated that these types of adhesives by their very nature would have a surface tension where it moves smoothly on the upper surface of the pattern.

As to claim 2, the adhesive used in Brault is capable of being colored by paint.

Regarding applicant claims 4, 5, 10, and 11, Brault discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet by coating (column 8, lines 55-59).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault as applied to claim 1 above, and further in view of Sandor (US Patent No. 6,110,317).

Brault discloses a transfer method wherein the transfer sheet includes an intermediate layer (26) between the release layer (30) and the image layer (18) which, upon transfer, remains attached in an overlaying relationship to the image layer (18) adhered to the substrate (20) by adhesive layer (22). Brault further discloses that the intermediate layer (26) is transparent and protects the image (18) from abrasion, fading, chemical degradation or damage (column 9, lines 13-20).

Although they do not specifically disclose, as per applicant claim 3, that such a protective layer is applied over the transferred image after the transfer step has been carried out, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the protective layer of Brault either simultaneously with transfer or as a subsequent step following transfer motivated by the fact that Sandor, also drawn to method for the adhesive transfer of electrophotographic images from a transfer sheet to a target substrate (abstract), discloses that following transfer, the image can be overcoated with a layer of clear, durable seal coat resin, i.e., a varnish (column 7, lines 19-22., column 10, lines 40-50).

12. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Fukushima et al. (US Patent No. 3,716,360).

As set forth above in paragraph 7, Brault discloses forming a transfer sheet (24) with a pattern (18) formed on a release or remover layer (30). The pattern is transferred to another substrate using heat and pressure. While Brault does not specifically state the adhesive is transparent or semi-transparent, it is appreciated that in order for the indicia (18)

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to be seen in the final product, the adhesive must be either transparent or semi-transparent. While Brault discloses using heat and pressure to effect the transfer, Brault does not teach using the heat of an iron as required by claim 7. It would have been obvious to one having ordinary skill in the art at the time the invention was made that an iron is a well known method of heating and applying pressure to achieve the transfer in the method of Brault, this is shown for example in Fukushima where an electric iron is one alternative to soften the image to assist in the transfer operation. (Col. 3, lines 18-40.)

13. Claims 13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards (US Patent No. 3,334,003).

Regarding claim 13, as set forth above in paragraph 7, Brault discloses forming a transfer sheet (24) with a pattern (18) having an adhesive (22) applied onto the pattern (18). Brault specifically teaches that one type of adhesive can be a spray mount adhesive, but there is no specific teaching that brushing the adhesive on is an alternative. Edwards demonstrates that an obvious alternative to using a spray mount adhesive is to brush the adhesive onto the surface bearing the indicia to be transferred. It would have been obvious to one having ordinary skill in the art at the time the invention was made to brush the adhesive used in Brault, because Edwards teaches that spraying and brushing are functionally equivalent alternative expedient, both of which are known in the art.

Regarding claim 15, it is appreciated to an artisan, that an adhesive would have surface tension greater than that of water. The adhesive is not meant to flow or move a great deal across a surface, while water would flow easily and not remain in place.

Regarding claim 16, because a brush is being used to spread the adhesive in Brault in view of Edwards, the artisan would appreciate that the adhesive must have a surface tension which enables it to be spread.

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Regarding claim 17, Brault discloses that the transfer sheet (24, 26) may utilize a release layer ("remover layer") (30) disposed over the carrier sheet.

14. Claim 14 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, further in view of Fukushima et al.

As set forth above in paragraphs 7 and 11 above, Brault discloses forming a transfer sheet (24) with a pattern (18). The pattern is transferred to another substrate using heat and pressure. While Brault discloses using heat and pressure to effect the transfer, Brault does not teach using the heat of an iron as required by claim 14. It would have been obvious to one having ordinary skill in the art at the time the invention was made that an iron is a well known method of heating and applying pressure to achieve the transfer in the method of Brault in view of Edwards, this is shown for example in Fukushima where an electric iron is one alternative to soften the image to assist in the transfer operation. (Col. 3, lines 18-40.)

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Sandor.

There is no discussion in Brault or Edwards of over-transferring, which is defined in applicant's specification as transferring an image onto another image. Sandor shows multiple images being transferred in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made that transferring an image on top of another image to achieve a desire effect of layered images, as shown in Sandor.

16. Claims 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Edwards '131 (US Patent No. 4,994,131).

Brault in view of Edwards does not discuss adding coloring to the adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to add a white paint or some other kind of coloring to the adhesive in Brault in view of Edwards, because one of ordinary skill in the art would appreciate that using paint in the adhesive can result in changing the resulting image which ends up being viewed.

Furthermore, Edwards '131 teaches adding paint to the adhesive can result in a smoother finish to the surface. (Col. 5, line 42 through Col. 6, line 2.)

Regarding claim 22, it is appreciated that since a brush is used to apply the adhesive, that same brush could be used to mix the paint with the adhesive.

17. Claims 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brault in view of Edwards as applied to claim 13 above, and further in view of Sandor.

Brault in view of Edwards does not specifically disclose, as per applicant claim 21, that such a protective layer is applied over the transferred image after the transfer step has been carried out, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the protective layer of Brault in view of Edwards either simultaneously with transfer or as a subsequent step following transfer motivated by the fact that Sandor, also drawn to method for the adhesive transfer of electrophotographic images from a transfer sheet to a target substrate (abstract), discloses that following transfer, the image can be overcoated with a layer of clear, durable seal coat resin, i.e., a varnish (column 7, lines 19-22., column 10, lines 40-50).

Response to Arguments

18. Applicant's arguments filed 01 December 2005 have been fully considered but they are not persuasive.

19. Regarding applicant's arguments on page 14 of the response, applicant argues Brault cannot anticipate claim 1, because the adhesive in Brault does not have a surface tension such that it moves smoothly on the pattern, the examiner disagrees with this position. Since

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the adhesive used in Brault is the same type used by applicant, it stands to reason, the adhesive would have the same property. While, Brault does not explicitly talk about the surface tension of the adhesive, it is implicit in the type of adhesive used and in the manner that Brault is using the adhesive.

20. As for the argument on page 15 of the response, in particular that Brault does not have the capability of transferring patterns such they can overlay each other, again the examiner disagrees. Brault is merely drawn to transferring print images, there is nothing in Brault which would lead one to deduce the pattern is not "able to overlay on another" as required by the claim.

21. Applicant is reminded that "[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). (See MPEP 2143.03.)

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
February 6, 2006